

REMARKS

In response to the Final Office Action mailed November 24, 2009, (hereinafter "Office Action")¹, the response for which is due by February 24, 2010, Applicant respectfully requests reconsideration of this application and the timely allowance of the currently pending claims 1, 4, 7, 9-11, 13, 16, 19, and 21- 23 and new claims 25-41.

I. STATUS AND DISPOSITION OF CLAIMS

In the instant application, claims 1, 4, 7, 9-11, 13, 16, 19, and 21- 23 are pending. Claims 1 and 13 are independent. In the Office Action, the following actions were taken:

- Claims 1, 4, 7, 9-11, 13, 16, 19, and 21-23 were rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. See Office Action at 5.
- Claims 13, 16, 19, and 21-23 were rejected under 35 U.S.C. § 101 as allegedly being directed towards non-statutory subject matter. See Office Action at 6.
- Claims 1, 4, 7, 13, 16, and 19 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Schroeder et al. (US 2003/0130883 - hereinafter "Schroeder"), in view of Examiner's Official Notice as supported by Gatto (US 20030065601 A1 - hereinafter "Gatto"). See Office Action at 7-10.
- Claims 9-11 and 21-23 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Schroeder in view of Examiner's Official Notice as supported by Gatto, and further in view of Cox et al. (US 20020143604 A1 - hereinafter "Cox"). See Office Action at 10-11.

II. AMENDMENTS TO THE CLAIMS AND NEW CLAIMS

In this Amendment and Response, claims 1, 7, 13, and 19 have been amended to place them in condition for allowance. Many of the amendments improve readability. In addition, new claims 25-41 have been added. Support for the amendments and new claim may be found at least in Applicant's Specification at, for example, the Abstract,

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

paragraphs [0004] and [0022], and the claims as filed. No new matter had been added. Upon entry of the amendments and the new claims, claims 1, 4, 7, 9-11, 13, 16, 19, 21-23, and 25-41 will be pending in this application.

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 11, 4, 7, 9-11, 13, 16, 19, and 21-23 in condition for allowance. Applicant submits that the proposed amendments of claims 1, 7, 13, and 19 and the addition of new claims 25-41 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicant respectfully points out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

III. ARGUMENTS

Based on the reasoning presented below, Applicant respectfully traverses the final condition of the application and the above-identified rejections, and requests the removal of the application from final condition, the withdrawal of the rejections, and the timely allowance of the pending claims.

A. Official Notice and Finality of Office Action.

As an initial matter, Applicant respectfully submits that the Examiner's designation of the Office Action as Final was improper. The Office Action articulates no reason for why the Office Action is made final. See Office Action at 9. However, the

finality of this Office Action does not allow Applicant the opportunity to challenge the notoriety of the cited *Gatto* reference, which was used as support for the Official Notice.

As explained in M.P.E.P. § 2144.03 (A), “[w]hile ‘official notice’ may be relied on, these circumstances should be rare when an application is under final rejection.” “[i]t might not be unreasonable for the examiner in a first Office Action to take official notice of facts” to “fill in the gaps” “to support a particular ground of rejection.” *Id.*, emphasis added.

The Examiner has taken Official Notice that it was allegedly “well known to those of ordinary skill in the art, at the time of the invention, to calculate and display percent errors between forecasted data and actual data when evaluating the predictive capacity of a particular model.” Office Action at 9. The Official Notice was first taken by the Examiner in the Office Action of April 14, 2009 at 7. Applicant again respectfully submits that this allegedly known fact is in fact not capable of “such instant and unquestionable demonstration as to defy dispute.” M.P.E.P. § 2144.03 (A) (citing *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970)). Applicant does not believe that the Officially Noticed facts defy dispute.

As originally explained in its Rely to Office Action, which was submitted July 13, 2009 (“Reply”), the Examiner’s statement is not “capable of instant and unquestionable demonstration of being well-known.” Reply at 7. Further, “the alleged noticed fact is not so well-known as to be universally applied.” Reply at 8.

In addition, the Examiner’s conclusions do not merely “fill in the gaps” in the rejections “in an insubstantial manner.” According to MPEP 2144.03,

[a]ny rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner’s conclusion should be judiciously applied. Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to “fill in the gaps” in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection.

Applicant respectfully submits that the Examiner has personally recognized that, without the (inappropriate) Official Notice, *Schroeder* is not a viable basis for an obviousness rejection. Thus, the Examiner’s reliance on his conclusion does more than “fill in the gaps’ in an insubstantial manner” in the Examiner’s evidentiary showing for

supporting his obviousness rejection. Applicant respectfully submits that the rejections based on the Examiner's misplaced conclusion are not judiciously applied.

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art.

M.P.E.P. 2144.03, quoting *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21, emphasis in original. In this Office Action, the Examiner has cited *Gatto* as alleged support for the Official Notice. According to the Office Action, *Gatto* was cited as exemplary evidence that it was allegedly "well known at the time of the invention to calculate the percentage difference between actual and forecasted data." Office Action at 9. However, Applicant notes that *Gatto* is not "recognized as standard in the pertinent art." In addition, *Gatto* was even not published until after the filing of the provisional application from which the instant application claims priority. Therefore, whether or not *Gatto* shows "calculat[ing] the percentage difference between actual and forecasted data," which Applicant does not concede, *Gatto* is not effective for establishing what was "well known at the time of the invention." Applicant therefore respectfully traverses, under M.P.E.P. § 2144.03 (C), the taking of Official Notice.

In addition, Applicant respectfully submits that the citation of *Gatto* as support for Official Notice, even if *Gatto* is simply offered to buttress a previous analysis or inference, is a new supporting position or rationale, which constitutes a "new ground for rejection." *In re Kumar*, 418 F.3d 1361, 1367, 76 USPQ2d 1048, 1051 (Fed. Cir. 2005) (a new calculation applied to a reference is not "simply an additional explanation of the Board's decision," it is a new ground of rejection); *In re Ahlert*, 424 F.2d 1088, 1098, 165 USPQ 418, 421 (CCPA 1970) (new facts based on an existing reference are a new ground of rejection, even if cast as "official notice"). In this case, where the new ground of rejection was neither necessitated by Applicant's amendment of claims nor based on information submitted in an information disclosure statement filed during the period set

forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), the final condition of the Office Action is improper and should be withdrawn.

Applicant therefore requests withdrawal of the application from Final condition.

B. The Rejection Of Claims 1, 4, 7, 9-11, 13, 16, 19, And 21-23 Under 35 U.S.C. § 112, First Paragraph For Lack Of Written Disclosure Should Be Withdrawn.

Appellant respectfully requests the withdrawal of the rejection of claims 1, 4, 7, 9-11, 13, 16, 19, and 21-23 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. The Office Action states,

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention. Specifically, the Examiner has been unable to discern support for using a computer to execute the steps recited in claims 1, 4, 7, and 9-11, or for the system being a computer-implemented system using computer-executable modules. The lack of support for these feature raises doubt as to possession of the claimed invention at the time of the filing.

Office Action at 5.

Appellant respectfully submits that claims are adequately supported by a written description. For example, FIG. 3 specifically illustrates a “a generating module that displays both (i) the forecasted consumer demand, the actual consumer demand, and a first percent error between the forecasted consumer demand and the actual consumer demand; and (ii) the forecasted shipments, the actual shipments, and a second percent error between the forecasted shipments and the actual shipments,” as recited in claim 13.

As explained in the Specification, “Figure 3 is a representation of an input screen that may be used for detailing forecasted demand and shipments and assessing and tracking forecast variances.” Specification at 8, para. [0022]. Figure 3 as filed is a screen shot of the input screen, evidencing that an embodiment of the invention was in existence at the filing of the application. The foregoing disclosure demonstrates that the inventors had possession of the invention.

Additionally, Applicant notes that the Abstract discloses, “A customized software tool may analyze the impact of marketing activities on future sales by forecasting

consumer demand and retail-load adjustments for a product or service, based upon past results.” Abstract. The Specification also discloses, “The invention includes a customized software tool that assists businesses to analyze the impact of marketing activities on future sales by forecasting consumer demand, retail-load adjustments, and shipments for a particular product or service based upon past results.” Specification at 2, para. [0004].

The recited “processor,” “display device,” “user interface,” “distinct software modules,” and “memory” are known components of systems that employ “a customized software tool.”

Further, the Manual of Patent Examination Procedure (MPEP) § 2163.02 specifies, “The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.” The Specification discloses, “The invention includes a customized software tool.” Specification at 2, para. [0004]. It is well known that software tools require processors, distinct software modules, display devices, user interfaces, and memory components for implementation.

Fig. 2 and the Specification discloses examples of the distinct software modules for the system that includes the customized software tool:

- para. [0020]: marketing plan providing module 202, historical data gathering module 204, and historical data analyzing module 206;
- para. [0022]: user input enabling module 208 and marketing plan modifying module 210;
- para. [0023]: marketing plan executing module 212; marketing plan data results inputting module 214; and reasons assessing module 216; and
- para. [0024]: forecast variance explanation input enabling module 218; forecast error logging module 220; and report generating module 222.

Because the functionality of the modules are disclosed in detail in the Specification in the above-cited locations and elsewhere in the Specification, according to MPEP § 2163, the modules are adequately described in the Specification.

As a general rule, where software constitutes part of a best mode of carrying out an invention, description of such a best mode is satisfied by a disclosure of the functions of the software. This is because, normally, writing code for such

software is within the skill of the art, not requiring undue experimentation, once its functions have been disclosed. *** Thus, flow charts or source code listings are not a requirement for adequately disclosing the functions of software.

MPEP § 2163, quoting *Fonar Corp. v. General Electric Co.*, 107 F.3d 1543, 1549, 41 USPQ2d 1801, 1805 (Fed. Cir. 1997).

Applicant respectfully submits that the implications of a processor, distinct software modules, and memory as derived from the figures and the Specification is amply sufficient to satisfy the description requirement. Thus, the disclosure in the Specification and Figs. 2 and 3 describe a "processor," "distinct software modules," and "memory" as claimed.

Applicant submits that the disclosure in the Specification and illustrated in Figs. 2 and 3 of the computer-based modeling techniques and analysis tool necessarily discloses the functionality of the processor, distinct software modules, and memory, and that the disclosure of such functionality is "a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and [it sets] forth the best mode contemplated by the inventor of carrying out his invention," as is required by 35 U.S.C. § 112, first paragraph.

As such, amended claim 13, reciting

a processor; at least one memory storing data and instructions; a display device; a user interface; and distinct software modules embodied on a computer-readable medium; wherein the distinct software modules comprise a providing module . . . ; a quantifying module . . . ; a forecasting module. . . ; a modifying module . . . ; an executing module . . . ; and a generating module . . . ;

and related dependent claims 16, 19, and 21-23, meet the requirements of 35 U.S.C. § 112, first paragraph.

Claim 1, while different in scope, recite similar elements. Therefore, for the same reasons, claim 1 (and related dependent claims 4, 7, and 9-11) meet the requirements of 35 U.S.C. § 112, first paragraph.

In view of the above, Applicant respectfully requests the withdrawal of the rejection of claims 1, 4, 7, 9-11, 13, 16, 19, and 21-23 under 35 U.S.C. § 112, first paragraph.

C. The Rejections of Claims 13, 16, 19, And 21-23 Under 35 U.S.C. § 101 Should Be Withdrawn.

Applicant respectfully traverses the rejection of claims 13, 16, 19, and 21-23 under 35 U.S.C. § 101, as allegedly being directed to non-statutory matter. The Office Action points out correctly that the claims "are directed toward a system comprising various modules," but the Office Action continues, "The claims do not positively recite elements that necessarily constitute a system or apparatus, rather the claims could be directed to software. *Software per se* is not patentable under § 101; therefore, the claimed invention does not fall within a statutory class of patentable subject matter." Office Action at 6, emphasis in original.

Applicant respectfully submits that pending claims 13, 16, 19, and 21-23 properly recited "elements that necessarily constitute a system or apparatus." For example, independent claim 13 presented hardware and software components, such as "[a] computer-implemented system."

Thus, Applicant respectfully disagrees with and traverses this rejection, but makes amendments to place claims in allowable condition. Among other elements, claim 13 now recites:

- a processor;
- at least one memory storing data and instructions;
- a display device;
- a user interface; and
- distinct software modules embodied on a computer-readable medium.

In addition, claim 13 recites with specificity the functionality of the distinct software modules. For the sake of brevity, the functionality of each of the software modules recited in claim 13, which is found above in the Amendments to the Claims section, is not repeated here. The Office Action cites no support, and there is no

support, for its statement that "Software *per se* is not patentable under § 101." The MPEP, for example, includes direction to the contrary. "When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized." M.P.E.P. 2106.01. Therefore, all of the elements of amended claim 13 are clearly statutory.

In addition, Applicant directs the Examiner's attention to the specifications and allowed claims in other applications commonly assigned to Applicant's assignee. See, for example, USSN 10/302,395 and USSN 10/317,213.

Accordingly and in view of the totality of these exemplary precedents, Applicant respectfully requests the withdrawal of the rejection of claims 13, 16, 19, and 21-23 under 35 U.S.C. § 101.

D. The Rejections of Claims 1, 4, 7, 13, 16, And 19 Under 35 U.S.C. § 103(a) Should Be Withdrawn.

Applicant respectfully traverses the rejection of claims 1, 4, 7, 13, 16, and 19 under 35 U.S.C. §103 as allegedly being unpatentable over *Schroeder*, in view of Examiner's Official Notice as supported by *Gatto*. See Office Action at 7-10. A *prima facie* case of obviousness has not been established.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008) (internal citation and inner quotation omitted). "[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). In rejecting a claim, "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

Claim 13 calls for a combination including, for example, “a generating module that **displays both (i) the forecasted consumer demand, the actual consumer demand, and a first percent error** between the forecasted consumer demand and the actual consumer demand; and (ii) the **forecasted shipments, the actual shipments, and a second percent error** between the forecasted shipments and the actual shipments.” See Claim 13, emphasis added.

As conceded by the Examiner, *Schroeder* fails to teach or suggest “display[ing] both (i) . . . consumer demand . . . ; and (ii) . . . shipments,” as recited in claim 13. The Examiner took Official Notice that it was allegedly “well known to those of ordinary skill in the art, at the time of the invention, to calculate and display percent errors between forecasted data and actual data when evaluating the predictive capacity of a particular model.” Office Action of April 14, 2009 at 7. As discussed in detail above, this allegedly known fact is in fact not capable of “such instant and unquestionable demonstration as to defy dispute.” MPEP § 2144.03 (A) (citing *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970)). For the reasons noted above, Applicant does not believe that the Official Notice facts defy dispute.

Finally, even assuming that the Examiner’s Official Notice is correct and that the Examiner’s citation of *Gatto* as support for the Official Notice is proper, both of which Applicant disputes, the Official Notice and *Gatto* both fail to cure the deficiencies of *Schroeder* identified by the Examiner and noted above. That is, neither the Official Notice nor *Gatto* teaches or suggests “a generating module that **displays both (i) the forecasted consumer demand, the actual consumer demand, and a first percent error** between the forecasted consumer demand and the actual consumer demand; and (ii) the **forecasted shipments, the actual shipments, and a second percent error** between the forecasted shipments and the actual shipments,” as recited in claim 13.

Neither the Official Notice nor *Gatto* teaches or suggests the display of **two** parameters. Applicant notes that, as recited, both demand **and** volume are displayed. Applicant reminds the Examiner that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” MPEP 2143.03, quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Therefore, regardless of whether it was appropriate to take Official Notice that it was allegedly "well known to those of ordinary skill in the art, at the time of the invention, to calculate and display percent errors between forecasted data and actual data when evaluating the predictive capacity of a particular model," it is not old and well known to provide "a generating module that **displays both** (i) the **forecasted consumer demand, the actual consumer demand, and a first percent error** between the forecasted consumer demand and the actual consumer demand; and (ii) the **forecasted shipments, the actual shipments, and a second percent error** between the forecasted shipments and the actual shipments," as recited in claim 13.

In view of the mischaracterization identified above, the Examiner has neither properly determined the scope and content of the prior art nor ascertained the differences between the claimed invention and the prior art. For at least this reason, no *prima facie* case of obviousness has been established.

The rejection of claim 13, and dependent claims 16 and 19, under 35 U.S.C. §103 as allegedly being unpatentable over *Schroeder*, in view of Examiner's Official Notice as supported by *Gatto*, is thus improper and should be withdrawn. In addition, the rejection of independent claim 1, which although different in scope, recites limitations similar to those in claim 13, and claims 4 and 7 depending directly from claim 1 are also improper and should be withdrawn.

E. The Rejections of Claims 9-11 And 21-23 Under 35 U.S.C. § 103(a) Should Be Withdrawn.

Dependent claims 9-11 and 21-23 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Schroeder* in view of Examiner's Official Notice as supported by *Gatto*, and further in view of *Cox*. Since these are all dependent claims that incorporate the individual claim elements of claims 1 and 13, these dependent claims all recite claim elements not disclosed in *Schroeder*, *Cox*, or any art of record. Accordingly, the rejection of claims 9-11 and 21-23 under 35 U.S.C. 103(a) should be withdrawn at least for the reasons given above with respect to claims 1 and 13.

F. New Claims 25-41 Are Allowable.

New independent claim 25, although different in scope, recites limitations similar to those in claims 1 and 13. Therefore, for the reasons described above, claim 25 is also allowable over *Schroeder*, with or without the Examiner's Official Notice, and whether or not supported by *Gatto*.

New independent claim 26 and related dependent claims 27-32 are directed to a "computer-implemented method for using econometric techniques to quantify marketing drivers and forecast consumer demand and shipments." Among other elements, claim 26 recites, "providing, by the marketing plan providing module, at least one marketing plan, wherein the at least one marketing plan comprises at least two marketing elements [and] using econometric modeling, by the historical data analyzing module, to quantify the relative effect of the at least two marketing elements on shipments."

Applicants respectfully submit that none of the cited references, nor the Official Notice taken by the Examiner, teaches or suggests "the at least one marketing plan compris[ing] at least two marketing elements" and "using econometric modeling . . . to quantify the relative effect of the at least two marketing elements on shipments" recited in claim 26.

Schroeder discloses a "method and system for predicting the profit attributable to a proposed sales promotion of a product." *Schroeder*, Abstract. In contrast, Applicant's Specification specifically discloses that a marketing plan encompasses more than just sales promotions. "The elements of the marketing plan **may include** promotions, advertising, points of distribution, product changes, etc. that may be offered to consumers." Specification at 2, para. [0004], emphasis added. Fig. 3 shows more than one element being analyzed. Thus, the Specification discloses other marketing elements beyond sales promotions. Because *Schroeder* is limited to only sales promotion, it does not teach or suggest "the at least one marketing plan compris[ing] at least two marketing elements" and "using econometric modeling . . . to quantify the relative effect of the at least two marketing elements on shipments" recited in claim 26.

Neither *Cox* nor *Gatto* nor the Official Notice taken by the Examiner cures the deficiencies of *Schroeder*, discussed above. That is, *Cox*, *Gatto*, and the Official Notice

also, fail to teach or suggest "the at least one marketing plan compris[ing] at least two marketing elements" and "using econometric modeling . . . to quantify the **relative effect** of the at **least two marketing elements** on shipments" recited in claim 26.

In addition, the new independent claims 33 and 40, which, although different in scope, recite limitations similar to those in claim 26, and claims 34-39 and 41, depending respectively therefrom, are also allowable over the cited references and the Official Notice.

Thus, Applicant respectfully submits that new claims 26-41 are also allowable over *Schroeder*, with or without the Examiner's Official Notice, and whether or not the Official Notice is supported by *Gatto*.

IV. CONCLUSION

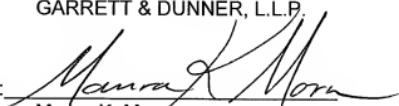
In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By:


Maury K. Moran
Reg. No. 31,859
(617) 452-1657

Dated: January 22, 2010